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| 10/038,506 | 11/09/2001 | Michael D. Hooven | HOOV 114 | 6492 |
| 7590 | 09/30/2008 | | EXAMINER | |
| Cook, Alex, McFarron, Manzo, Cummings & Mehler, Ltd. Suite 2850 200 West Adams Street Chicago, IL 60606 | | | CHEN, VICTORIA W | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/038,506 | HOOVEN, MICHAEL D. | |
| | Examiner | Art Unit | |
| | VICTORIA W. CHEN | 3739 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 16 September 2008.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-7 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-7 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 3/22/02 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application

6) Other: _____.

DETAILED ACTION

Claim Objections

Claims 1, 4 and 6 are objected to because of the following informalities:

Claim 1, ll. 7-9, "in which clamped position the portions of the first and second jaws being substantially parallel to each other in the clamped position" is repetitive.

Claim 1, ln. 25, "directly opposed to other" should be --directly opposed to each other--.

Claim 4, ln. 2, "grasping jaws spaced apart" should be --grasping jaws are spaced apart--.

Claim 6, ln. 1, "the each" should be --each--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the portions" in ln. 7. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Yamauchi et al. (US 6273887 B1) in view of Chen et al. (US 6102909).

Regarding claim 1, Yamauchi teaches a device having first [548a] and second [548b] jaws movable between a first open position [Fig. 74A] and a second clamped position [Fig. 74B], in which portions of the first and second jaws are substantially parallel to each other [Fig. 74B] in the clamped position, each jaw including a clamping surface [Fig. 74B, e.g. for jaw 548a, the clamping surface is interpreted as the bottom surface of 548a, closest to the tissue A, and the surfaces 550 and 551 of element 549a] having a width [width of 548a], a first elongated electrode [549a] extending along the clamping surface of the first jaw and forming a part thereof, the first elongated electrode having a tissue contacting portion [550] which has a length and a width, the clamping surface including non-conductive portions [552, col. 41, ll. 18-23] disposed on each side of the tissue contacting portion of the first electrode, the width of the clamping surface exclusive of the width of the tissue contacting portion of the first electrode being wider than the width of the tissue contacting portion, a second elongated electrode [549b] extending along the clamping surface of the second jaw and forming a part thereof, the second elongated electrode having a tissue contacting portion [550] which has a length and a width, the clamping surface including non-conductive portions [552, col. 41, ll. 18-23] disposed on each side of the tissue contacting portion of the second electrode, the width of the clamping surface exclusive of the width of the tissue contacting portion of the second electrode being wider than the width of the tissue contacting portion, the tissue contacting portions of the first and second electrodes being substantially directly opposed to each other along at least a part of their lengths [Fig. 74B] and capable of being adapted to be connected to an RF energy source so that the first and second

electrodes are of opposite polarity and operable to create a line of ablation narrower than the width of the clamping surface. Yamauchi fails to specifically teach a first and second handle members associated with the first and second jaws for opening and closing the jaws. Instead, Yamauchi teaches using a camming mechanism to operate the jaws [Fig. 41, ll. 6-9]. However, Yamauchi teaches another embodiment [Figs. 1A, 1B] with first [8a] and second [8b] jaws which are moved by an associated first and second handle members [17, 6] into an opened and closed position. It would have been obvious to one of ordinary skill in the art to substitute the first and second handle members as taught by an embodiment of Yamauchi for the camming mechanism to achieve the predictable result of opening and closing the first and second jaw members. Yamauchi further fails to teach portions of the first and second jaws being substantially parallel to each other through a range of tissue clamping spacing. Chen teaches a bipolar electrosurgical instrument [Fig. 3] having first and second jaws with first and second electrodes which are opened and closed via associated handle members, and where portions of the jaws are parallel to each other through a range of tissue clamping spacing in order to allow for simultaneous cutting and cauterization of a linear section of tissue while reducing the amount of trauma to tissue during cutting [col. 19, ll. 16-45]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the device as taught by Yamauchi by making the jaws parallel to each other through a range of tissue clamping spacing as taught by Chen in order to allow for simultaneous cutting and cauterization of a linear section of tissue while reducing the amount of trauma to tissue during cutting.

Regarding claim 2, Yamauchi teaches a predetermined spacing between the jaws when in the clamped position in order to prevent a short circuit between the electrodes [col. 40, ll. 66-67,

col. 41, ll. 1-5], but fails to specify the spacing being between 1-15 mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the spacing as taught by Yamauchi since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claim 3, Yamauchi teaches first [548a] and second [548b] jaws movable between open [Fig. 74A] and closed positions [Fig. 74B], in which portions of the first and second jaws are substantially parallel to each other [Fig. 74B] in the closed position, each jaw including an electrode [549a, 549b] and clamping surface [Fig. 74B, e.g. for jaw 548a, the clamping surface is interpreted as the bottom surface of 548a, closest to the tissue A, and the surfaces 550 and 551 of element 549a] in face to face relation with the electrode and clamping surface of the other jaw [Fig. 74B], each clamping surface having a width [width of 548a or 548b] and including non-conductive portions [552, col. 41, ll. 18-23], each elongated electrode extending along the clamping surface and forming a part thereof, each electrode having a tissue contacting portion [550] which has a length and a width, the width of each clamping surface exclusive of the width of the tissue contacting portion of the respective electrode being wider than the width of the tissue contacting portion, the tissue contacting portion of the electrodes being substantially directly opposed to each other along at least a part of their lengths [Fig. 74B], the electrodes capable of being of opposite polarity and capable of being adapted to be connected to a power source for providing an electrical current so that when activated the electrodes are operable to create a line of ablation narrower than the width of the clamping surface. However, Yamauchi further fails to teach portions of the first and second jaws being substantially parallel

to each other through a range of tissue clamping spacing. Chen teaches a bipolar electrosurgical instrument [Fig. 3] having first and second jaws with first and second electrodes which are opened and closed via associated handle members, and where portions of the jaws are parallel to each other through a range of tissue clamping spacing in order to allow for simultaneous cutting and cauterization of a linear section of tissue while reducing the amount of trauma to tissue during cutting [col. 19, ll. 16-45]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the device as taught by Yamauchi by making the jaws parallel to each other through a range of tissue clamping spacing as taught by Chen in order to allow for simultaneous cutting and cauterization of a linear section of tissue while reducing the amount of trauma to tissue during cutting.

Regarding claim 4, Yamauchi teaches a predetermined spacing between the jaws when in the clamped position in order to prevent a short circuit between the electrodes [col. 40, ll. 66-67, col. 41, ll. 1-5], but fails to specify the spacing being between 1-15 mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the spacing as taught by Yamauchi since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claim 5, Yamauchi teaches the clamping surfaces of the jaws comprise insulating material [552].

Regarding claims 6 and 7, Yamauchi teaches each electrode is generally centrally located relative to the width of the respective clamping surface [Fig. 74B].

Response to Arguments

Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

References Yamauchi and Chen have been applied above to address applicant's new claim amendments.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTORIA W. CHEN whose telephone number is (571)272-3356. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victoria W Chen/

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Examiner, Art Unit 3739

/Henry M. Johnson, III/
Primary Examiner, Art Unit 3739